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| EXAMINER | |
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| PHAN, TUANKHANH D | |
| ART UNIT | PAPER NUMBER |
| 2109 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/693,516 | SATAGOPAN ET AL. | |
| | Examiner | Art Unit | |
| | TuanKhanh Phan | 2109 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *October 23, 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☒ Claim(s) *35-42* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *October 23, 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *June 30, 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Oath/Declaration*

1. Oath/Declaration is objected to because it does not identify the city and state of residence of second inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration. Appropriate correction is required.

### *Specification*

2. Claim 3 is objected to because of the following informalities: "... comprises **and** IP address". Appropriate correction is required.

### *Drawings*

3. The drawing (Figure 1) is objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "100" and "102". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

4. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures.

If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claim 35** is rejected because the claim fails to place the invention squarely within one statutory class of invention. On page 11, lines 15-30 and pages 12, lines 7-20 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e. abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.")

7. **Claims 36-38, and 42** are rejected as being dependent on rejected claim 35.

8. **Claims 39-40, and 41** are rejected as being dependent on rejected claims 38 and 40 respectively.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless:
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1, 3, 5-7, 10, 23, 25, 30, 32, 35, and 37** are rejected under 35 U.S.C. 102(b) as being anticipated by Lui et al. ("Interoperability of Peer-to-Peer File Sharing Protocols", August 2002).

Regarding **claim 1,** Lui et al. disclose a file sharing method stored on a computer system peer one through a computer system peer two connected in a network environment (p. 25, ¶ 2; Figure 4; p. 29, ¶ 2) comprising: stored identity information file from the first peer, the said identity information file comprising a set of interfaces identifying a principal and machine location for the first peer system (p. 29, ¶ 2); receiving a request for access to document files when the request is directed to the user interface (p. 33, ¶ 1); replacing the user interface with peer machine location (Figure 6; p. 33, ¶ 1); sending request for access to document files to the machine location of the first peer system (Figure 4; p. 29, ¶ 2).

Regarding **claim 3**, Lui et al. disclose the method of claim 1 above wherein the peer location comprises an IP address to discover other peers (p. 26, ¶ 3).

Regarding **claim 5,** Lui et al. disclose the method of claim 1 above wherein the peer location comprises a principal-initiated request (Figure 3; p. 28, ¶ 2).

Regarding **claim 6**, Lui et al. disclose the method of claim 1 further comprising an initial step of receiving the identity information document from the first computer (p. 25, ¶ 2; Figure 3; p. 28, ¶ 2).

Regarding **claim 7,** Lui et al. disclose a method of publishing documents between a plurality of nodes connected in a network environment (p. 25, ¶ 2; Figure 4; p. 29, ¶ 2), said method comprising: sending an identity information document from a publishing node to an accessing node (Figure 4; p. 29, ¶ 2), the identity information document comprising a user-friendly handle identifying a principal and a machine location for the publishing node (Figure 6; p. 33, ¶ 1); storing the identity information document on the accessing node (p. 29, ¶ 2); resolving the user-friendly handle with the machine location in a request for access to documents wherein the request is made from the accessing node to the publishing node (Figure 6; p. 33, ¶ 1); and sending the request for access to documents from the accessing node to the publishing node (Figure 4; p. 29, ¶ 2).

Regarding **claim 10**, Lui et al. disclose a method of claim 7 above wherein the machine location comprises an IP address (p. 26, ¶ 3).

11. **Claims 23, 30, and 35** are rejected for the same reason as discussed in claims 1 and 7 above.

12. **Claims 25, 32, and 37** are rejected for the same reason as discussed in claim 3 above with reference to discussion of claim 1.

13. **Claims 1, 3-7, 10-15, 17, 19-23, 25-30, 32-35, and 37-42** are rejected under 35 U.S.C. 102(b) as being anticipated by Boyle et al. (US Patent 5,872,847).

Regarding **claim 1**, Boyle et al. teach a method of communicating and accessing between a first computer system and a second computer system (abstract), the first and second computer systems connected in a network environment (abstract), said method comprising: determining identity information from the first computer (Col. 23, lines 33-65; Col. 24, lines 1-28), the identity information document wherein a user-friendly handle identifying a principal and a machine location for the first computer system (Col. 4, lines 23-65, "secure network interface unit [SNIU]"); receiving a request for access to documents (Col. 23, lines 33-65; Col. 24, lines 1-28); exchanging the user-friendly handle with the machine location address (Col. 4, lines 23-65; Col. 23, lines 33-65; Col. 24, lines 1-64).

Regarding **claim 3**, Boyle et al. teach a method of claim 1 wherein the machine location comprises an IP address (abstract; Col. 10, lines 24-52).

Regarding **claim 4**, Boyle et al. teach a method of claim 1 wherein the machine location comprises a public key (Col. 8, lines 50-61).

Regarding **claim 5**, Boyle et al. teach a method of claim 1 wherein the machine location comprise a principal-initiated request (abstract; Col. 8, lines 50-61, "Echo Request message").

Regarding **claim 6**, Boyle et al. teach a method of claim 1 wherein the machine location comprise receiving the identity information from the first user (abstract; Col. 23, lines 33-65).

Regarding **claim 7**, Boyle et al. disclose a method of communicating and accessing a plurality of nodes connected to one another in an Internet Protocol based computer network comprising: determining identity information from a publishing node (Col. 23, lines 33-65; Col. 24, lines 1-28), to an accessing node by a user-friendly handle identifying a principal and a machine location for the publishing node (Col. 4, lines 23-65); sending request for access to documents from the accessing node to the machine location of the publishing node (abstract; Col. 8, lines 50-61); receiving a request for access to documents (Col. 23, lines 33-65; Col. 24, lines 1-28); replacing the user-friendly handle with the node location address (Col. 23, lines 33-65; Col. 24, lines 1-64).

Regarding **claim 10**, Boyle et al. teach a method of claim 7 wherein the node location comprises an IP address (abstract; Col. 10, lines 24-52).

Regarding **claim 11**, Boyle et al. teach a method of claim 7 wherein the machine location comprises a public key (Col. 8, lines 50-61).

Regarding **claim 12**, Boyle et al. teach a method of claim 11 wherein the public key is used to determine the current machine location for the publishing node (Col. 8, lines 50-62; Col.26, lines 1-8).

Regarding **claim 13**, Boyle et al. teach a method of claim 11 above wherein a Secure DNS server having an encrypted machine name and location (Col. 2, lines 9-13,

Col. 8, lines 50-61); converting the public key to the encrypted machine name and to look up the registered machine location for the publishing node on the SDNS (Col. 22); sending the request to access to documents (Col. 20, lines, 2- 57).

Regarding **claim 14**, Boyle et al. teach a method of claim 7 comprises verifying the authorization of the accessing node to review the requested documents before utilizing the requested documents (abstract; Col. 20, lines 10-60; Col. 5, lines 13-57).

Regarding **claim 15**, Boyle et al. teach a method of claim 7 wherein delivering a path location for documents on the publishing node to the accessing node (Col. 22, lines 1-48).

Regarding **claim 17**, Boyle et al. teach a method of claim 15 wherein delivering a path location to a principal of the accessing node (Col. 20, lines 10-60).

Regarding **claim 19**, Boyle et al. teach a method of claim 7 wherein the resolving step comprises: receiving the request for access to documents when the request is directed to the user-friendly handle (Col. 4, lines 23-65; Col. 24, lines 29-64); finding a matching identity information document having a user-friendly handle that matches the user-friendly handle in the request (Col. 24, lines 29-64); determining the machine location from the matching identity information document (Col. 24, lines 29-64); and amending the request to substitute the user-friendly handle with the machine location (Col. 6, lines 52-64; Col. 24, lines 29-64).

Regarding **claims 20 and 21**, Boyle et al. teach a method of claim 7 comprising: adding a path name before sending out (Col. 21, lines 37-67); delivering the path name

with user-friendly interface to the accessing node (Col. 22, lines 4-64, "datagram"); and parsing the path name of accessing document and node location (Col. 22, lines 4-64).

Regarding **claim 22**, Boyle et al. teach a method of claim 7 wherein the identity information location comprise more than one machine location for principal identified by user interfaces (abstract; Col. 3, lines 46-62; Col. 6, lines 5-17).

Regarding **claim 23**, Boyle et al. teach a method of using a user-friendly handle to access documents stored on a first computer system in a network environment, the method comprising: storing an identity information document from the first computer system (Col. 23, lines 33-65; Col. 24, lines 1-28), the identity information document comprising a user-friendly handle identifying a principal and a machine location for the first computer system (Col. 6, lines 1-67); intercepting a request for access to documents in the form of the user- friendly handle (Col. 23, lines 33-65; Col. 24, lines 1-28); amending the request to replace the user-friendly handle with the machine location (Col. 4, lines 1-65); and sending the amended request to access the documents to the machine location of the first computer system (Col. 23, lines 33-65; Col. 24, lines 1-64).

Regarding **claim 25**, Boyle et al. teach a method of claim 23 wherein the machine location comprises an IP address (abstract; Col. 10, lines 24-52).

Regarding **claim 26**, Boyle et al. teach a method of claim 23 wherein the machine location comprises a public key (Col. 8, lines 50-61).

Regarding **claim 27**, Boyle et al. teach a method of claim 23 wherein using the public key to determine the user location of the publishing node (abstract; Col. 5, lines 2-25; Col. 8, lines 50-61).

Regarding **claims 28 and 29**, Boyle et al. teach a method of claim 23 receiving identity and right to access documents from a first user in a networking environment (abstract; Col. 8, lines 50-61).

Regarding **claim 30**, Boyle et al. teach an authentication server system comprising: a database storage list of identity information documents received from a node (Col. 12, lines 25-67), the identity information identifying a principal and a machine location for the second node (Col. 12, lines 25-67); and a the server connected to the database storage receiving requests for access to documents stored at the user-friendly interface and amending the request to replace the user-friendly interface with the machine location (abstract; Col. 7, lines 3-58; Col. 12, lines 25-67).

Regarding **claim 32**, Boyle et al. teach a system of claim 30 wherein the node location comprises an IP address (abstract; Col. 10, lines 24-52).

Regarding **claim 33**, Boyle et al. teach a system of claim 30 wherein the machine location comprises a public key (Col. 8, lines 50-61).

Regarding **claim 34**, Boyle et al. teach a system of claim 30 wherein a communication session connected to the identity resolution module for sending and receiving communication between nodes (Col. 8, lines 2-61; Col. 12, lines 25-67).

Regarding **claim 35**, Boyle et al. teach an authentication server system having a process wherein protocols for executing an identity resolution comprises: storing identity information documents from a node comprise a machine location for the publishing node (abstract, Col. 25-67); receiving a request for accessing to document from the publishing node (Col. 23, lines 33-65; Col. 24, lines 1-28); amending the request to

replace the friendly user interface with the node location (abstract; Col. 7, lines 3-58; Col. 12, lines 25-67).

Regarding **claim 37**, Boyle et al. teach the process of claim 35 wherein the machine location comprises an IP address (Col. 8; Col. 10, lines, 25-67).

Regarding **claims 38 and 39**, Boyle et al. teach the process of claim 35 where in the machine location comprises a public key to determine the publishing node (Col. 8, lines 3-67).

Regarding **claim 40**, Boyle et al. teach the process of claim 38 comprises registering an encrypted machine name and registered machine location with a DNS server (Col. 2, lines 9-13, Col. 8, lines 50-61); resolving, converting the public key to the encrypted machine name, and look up the registered machine location for the publishing node on the SDNS (Col. 5); sending the request to access to documents (Col. 10, lines 13-60).

Regarding **claim 41**, Boyle et al. teach the process of claim 49 wherein the converting step comprises performing an algorithm on the public key (Col. 7; Col. 8, lines 50-61).

Regarding **claim 42**, Boyle et al. teach a process of claim 35 wherein authentication server comprises more than one machine location for principal identified by the user friendly interface (Col. 5; Col. 11, lines 12-44).

14. **Claims 1-4, 7-8, 10-11, 16, 23-26, 30-33, and 35-38** are rejected under 35 U.S.C. 102(b) as being anticipated by Reiche (US Patent 6,092,196).

Regarding **claims 1, 7, 23, 30, and 35**, Reiche discloses an authentication server data network comprising: a plurality of nodes connected to one another by data transmission pathways (Col. 13, lines 1-67); identity information of nodes are stored on a database storage (abstract); the server being able to intercept a first message from a user at a certain node of said network requesting access to the certain resource (Col. 4, lines 13-67); issuing a response message to the certain node, said response message causing the certain node to initiate an access grant control transaction with said authentication server (Col. 4, lines 13-67); said authentication server capable to direct to the customer server a communication containing data permitting the customer server to generate and transmit to the certain node an access grant mark (Col 3.), the access grant mark being retained by the certain node and recognizable by the customer server as indication of past occurrence of access grant by said authentication server (Col. 12, lines 26-67).

Regarding **claims 2, 8, 16, 24, 31, and 36**, Reiche discloses user-friendly interfaces by transaction ID strings up to 128 bytes for user specific data (Col. 11, lines 45-67; Col. 12, lines 1-24). Email addresses are inherent 128-byte character strings.

Regarding **claims 3, 10, 25, 32, and 37**, Reiche discloses user-friendly interfaces by transaction ID strings up to 128 bytes for user specific data (Col. 11, lines 45-67; Col. 12, lines 1-24). IP addresses are inherent 128-bye character strings.

Regarding **claims 4, 11, 26, 33, and 38,** Reiche discloses user-friendly interfaces by transaction ID strings up to 128 bytes for user specific data (Col. 11, lines 45-67; Col. 12, lines 1-24). A public key is inherent 128-bye character strings.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. **Claims 2, 8, 16, 24, 31, and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (US Patent 5,872,847), as applied to claims 1, 7, 15, 23, 30, and 35 above, and in further view of Huitema et al. (US Patent 7,065,587).

Regarding **claims 2, 8, 16, 24, 31, and 36**, Boyle et al. teach limitations of claims 1, 7, 15, 23, 30, and 35; Boyle et al. do not teach the user-friendly handle comprising an email address.

Huitema et al. disclose a method of accessing between nodes comprising an email address (Col. 15, lines 50-55).

Since the use of email address is well known in the art for embedding in strings of datagrams, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the email address taught by Huitema et al. into the teaching of Boyle et al. to increase the accessibility between machine locations. It would have been obvious to one or ordinary skill in the art of networking at the time the invention was made to understand TCP/IP protocols and formats, as disclosed by Boyle et al. (abstract), include using email.

17. **Claims 9 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (US Patent 5,872,847), as applied to claims 7 and 17 above, and in further view of Johnson (US Patent 7,131,001).

Regarding **claims 9 and 18**, Boyle et al. teach limitations of claims 1, 7, 15, and 17; Boyle et al. do not teach the user-friendly handle comprising a telephone number or a telephone call.

Johnson discloses an apparatus and method wherein identification number and telephone voice call are essential for secured connection interfaces (Col. 16, lines 5-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Johnson into the teaching of Boyle et al. to increase the efficient measures and to reduce overheads among user nodes' connections.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

MS#167537.1 Microsoft Corporation, version 1. "Server-less Name Resolution Protocol." Author: Christian Huitema

U.S. Patent No. 6,047,376 [Apr. 4, 2000]. Makoto Hosoe. 713/201. 709/217. "Client-server System, Server Access Authentication Method, Memory Medium Stores Server-access Authentication Programs, and Issuance Device Which Issues the Memory Medium Contents."

U.S. Pub. No. 2002/0169892 [Nov. 14, 2002] Miyaoku et al. 709/246. "Token Type Content Providing System and Token Type content Providing Method and Portable User Terminal."

U.S. Patent No. 5,991,810 [Nov. 23, 1999] Shapiro et al. 709/229. "User Name Authentication for Gateway Clients Accessing A Proxy Cache Server".

U.S. Patent No. 6,026,433 [Feb. 15, 2000]. D'Arlach et al. "Method of Creating and Editing a Web Site in a Client-Server Environment Using Customizable Web Site Templates".

U.S. Pub. No. 2002/032780 [Mar. 14, 2002]. Moore et al. 709/220. "Systems and Methods for Uniquely Identifying Networks by Correlating Each Network Name With the Application Programming Interfaces of Transport Protocols Supported by the Network".

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TuanKhanh Phan whose telephone number is 571-270-3047. The examiner can normally be reached on Mon to Fri, 9:00am to 5:00pm EST, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on 571-272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tkp

PATRICK ASSOUAD
SUPERVISORY PATENT EXAMINER